

RECEIVED
CENTRAL FAX CENTER

002/007

OCT 28 2005

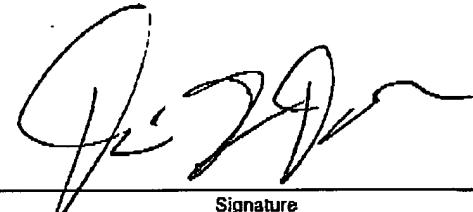
Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through 10/10/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>October 28, 2005</u>		Application Number	Filed
Signature <u>Stacie Herrera</u>		09/772,830	01/30/01
Typed or printed name <u>Stacie Herrera</u>		First Named Inventor	Frank K. Baker et al
		Art Unit	Examiner
		2188	Mehdi Namazi
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p>Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record: <u>41,711</u> Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p> Signature</p> <p><u>David G. Dolezal</u> Typed or printed name</p> <p><u>(512) 996-6839</u> Telephone number</p> <p><u>October 28, 2005</u> Date</p>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input checked="" type="checkbox"/> Total of <u>5</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER

OCT 28 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) Frank K. Baker, Jr. *et al.* GROUP ART UNIT: 2188
 APPLN. NO.: 09/772,830 EXAMINER: Mchdi Namazi
 FILED: January 30, 2001
 TITLE: A MEMORY SYSTEM AND METHOD OF ACCESSING THEREOF

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile
 transmitted to the Patent and Trademark Office.

on October 28, 2005

Stacie Herrera

Printed Name of Person Signing Certificate

STATEMENT OF REASONS FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Responsive to the Advisory Action dated October 20, 2005 (Second Advisory Action) and Examiner's comments with regard thereto, please enter the following remarks in the above-entitled application, without prejudice or disclaimer.

REMARKS

Claims 1-4, 6-10, and 12-26 are pending. Claim 15 has been allowed.

This case was on appeal. The Final Office Action of July 28, 2005 (Second Final Office Action) has reopened prosecution and a new grounds of rejection. Prior to the appeal, there was a First Non Final Office Action dated November 18, 2002, a Second Non Final Office Action dated April 8, 2003, a Third Non Final Office Action dated January 29, 2004, a First Final Office Action dated July 16, 2004, and an Advisory Action dated November 12, 2004.

Claims 1-4, 6-10, 12-14, and 16-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Okuno, U.S. Patent No. 6,105,114 (Okuno) in view of Morgan, U.S. Patent No. 6,083,271 (Morgan).

For this Statement, Applicants will be focusing on three specific points:

- 1) that the rejection of dependent claim 12 was improper in that the Second Final Office Action and the Second Advisory Action do not establish that a floating gate -type memory cell is inherent in Okuno;
- 2) that the Second Final Office Action and the Second Advisory Action do not establish a proper motivation under U.S.C. 103(a) to combine Okuno with Morgan;
- 3) that a battery backed RAM does not include non volatile memory cells.

1) Rejection of Dependent Claim 12 is Improper

The rejection of dependent claim 12 is improper in that neither Okuno nor Morgan disclose a floating gate-type memory cell, as recited by dependent claim 12. Accordingly, the Second Final Office Action and the Second Advisory Action do not set forth all essential elements needed for a prima facie rejection of this claim.

Applicants position is set forth on page 7 of the Response to Section Final Office Action dated September 28, 2005. Applicants respectfully request that the participants in this pre-appeal brief conference read that section.

In the Response to the Second Final Office Action, Applicants respectfully pointed out that a floating gate type cell is not explicitly taught by Okuno, nor is it inherent in the teachings of Okuno (as implied in the Second Final Office Action).

Also, in the Response to the Second Final Office Action, Applicants respectfully requested that the Examiner provide a basis in fact and/or technical reasoning to reasonably support the determination that a floating gate-type cell is necessarily present in the memory array of Okuno. However, the Second Advisory Action did not present such a basis. Accordingly, dependent claim 12 is allowable over Okuno and Morgan.

2) No proper motivation to combine Okuno and Morgan.

The rejection of the claims under 35 U.S.C. 103(a) over Okuno and Morgan is improper in that the Second Final Office Action did not present a proper motivation to one of skill in the art to combine Okuno and Morgan. Applicants' position on this issue is set forth on page 3 (first full paragraph) to the middle of page 6 of the Response to the Second Final Office Action. Applicants respectfully request that the participants in this pre-appeal brief conference read that section. The Second Advisory Action was silent as to this issue.

In regards to the motivation to combine Okuno with Morgan, the Second Final Office Action states "it would have been obvious to one having ordinary skill ... to incorporate the method of connecting a battery to a RAM device to make a non-volatile memory as taught by Morgan in corresponding to the storage device of Okuno ... in order to make the information stored in the battery-backed RAM device non-volatile (col. 6, lines 5-7)."

In the Response to the Second Final Office Action, Applicants stated that nowhere in Okuno does it require nor that it even suggest that its desirable to save the data in memory array 2 of Okuno when the power is removed.

Also, in the Response to the Second Final Office Action, Applicants stated that Okuno teaches away from adding the additional circuitry of a battery backed system as taught by Morgan. Okuno teaches (at many locations in its specification) that it is highly desirable to reduce circuit size and reduce power consumption.

Morgan on the other hand teaches that adding a battery back up for a RAM would require additional circuitry. In addition to the extra circuitry required for a battery back up system, the battery itself will take up additional space and require charging, monitoring, voltage regulation, and power management circuitry and software. Furthermore, when DC power is removed, Morgan teaches the cache 5 will be consuming battery power when the circuit is not in operation.

Thus, one of ordinary skill in the art would not be motivated to modify the memory array 2 of Okuno to provide a battery back up as taught by Morgan in that such a modification of would defeat the stated objectives of Okuno of reduced circuit size and reduced power consumption. Since nowhere in Okuno does it teach or even suggest the desirability of having a non volatile memory, one of skill in the art would not be motivated to add the extra circuitry and increased power consumption of a battery backed system to Okuno, especially since Okuno teaches the desirability of less circuitry, less space, and reduced power consumption. Accordingly, the claims 1-4, 6-10, 12-14, and 16-26 are allowable over Okuno and Morgan.

3. A battery backed RAM does not include non volatile memory cells

Claims 1-4, 6-10, 12-14, and 16-26 are allowable in that Okuno and Morgan do not disclose nonvolatile memory cells. See the middle of page 2 to the top of page 3 of the Response to the Second Final Office Action under subsection a) entitled "*The prior art does not teach non volatile memory cells.*"

Section 2 of the Second Final Office Action states that Morgan discloses a RAM which does not permanently store information. However, the Second Final Office Action states that "to make a RAM memory non-volatile, it is known to connect a battery to RAM device (col. 6, lines 4-6)."

Applicants respectfully submit that Morgan does not teach non volatile memory cells. Even if Morgan suggests that connecting a battery to the RAM provides a memory that is non-volatile, it does not change the volatile characteristics of the memory cells of the memory array.

The Second Advisory Action states that "a non-volatile memory by definition has non-volatile memory cells." Applicants respectfully disagree with this assertion in that the cells of a battery backed RAM are volatile memory cells that lose stored information once power is removed.

The Second Advisory Action also states that the specification of the present application states (at page 3, lines 17-19) that a "RAM" may be a suitable memory. However Applicants respectfully submit that the specification of the present application does not state or imply that a RAM is a non volatile memory. Accordingly, the Second Advisory Action is incorrect when it implies that the specification of the present Application supports its position.

Respectfully submitted,

By:



David G. Dolezal
Attorney of Record
Reg. No.: 41,711
Telephone: (512) 996-6839
Fax No.: (512) 996-6854

SEND CORRESPONDENCE TO:

Freescale Semiconductor, Inc.
Law Department

Customer Number: 23125